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BEYER WEAVER LLP P.O. BOX 70250 OAKLAND, CA 94612-0250			LE, KHANH H	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/699,631	Applicant(s) SAENZ, JAVIER
	Examiner KHANH H. LE	Art Unit 3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/19/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to the correspondence filed 05/19/2008. Claims 1-25 are pending. Claims 1, 4, 5, 10, 13, 16, and 21 are amended. Claims 1, 10, 16, and 21 are independent.

Claim Rejections - 35 USC § 112, first paragraph.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 16-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

Currently amended claim 16 recites:

*A method of award offering comprising:
receiving a description of an award, said award being associated with a profile
assigned to a patron of an establishment based at least in part upon substantially
real-time transaction activity of said patron;
based upon at least historical information involving patron and at least in part
upon the substantially real-time transaction activity of said patron, determining a
likelihood of the patron accepting the award; and
outputting information indicating whether the patron is likely to accept the*

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award; *receiving a script containing information relating to conveyance of said award;* and offering said award to said patron and ***conveying said information.***

The bolded language seems to have no clear support in the specification. The Examiner found paragraph [0197] of PGPub 20040143496 (reproduced below) to be the most plausible support for the claim yet this paragraph falls short of supporting the above language. (The most relevant language of the paragraph is highlighted in bold).

[0197] *If the award is accepted (Step 1816), then the patron is issued an award certificate (e.g., paper and/or electronic) (Step 1820), and the acceptance is recorded in the PCS database (Step 1822). If the award is not accepted (Step 1816), then the refusal is recorded in the PCS database 1612 (Step 1818). In this way, if a particular award is offered (e.g., a room) and the patron declines the award, then an indication that the patron declined that award type is placed in the player contact system database 1612 so that in the future, when the PCS bonusing system 1600 is assembling a collection of award types to be offered to the patron, **the fact that the patron has already said no to an offer (e.g., of a room) may be taken into consideration.** For example, if a patron has previously declined an award (e.g., of a room), then the declined award may still be available at a later time to offer to the patron, but another award may be highlighted so the declined award is not the first award offered again.*

That is, “*the fact that the patron has already said no to an offer (e.g., of a room) may be taken into consideration.*” does not specifically support “*outputting information indicating whether the patron is likely to accept the award;*”, especially “*information ..whether ...*” . Further “*another award may be highlighted so the declined award is not the first award offered again.*” does not specifically support “*conveying said information*” when “*offering said award to said patron*”.

In order to overcome this rejection it is suggested the claim be changed to mirror the specification language.

Claims 17- 18 are rejected based on their dependency.

Claim Rejections - 35 USC § 112, second paragraph.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. **Claims 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 16:

Because the support for the claim is not clear (see discussion of 35 U.S.C. 112, first paragraph above), its scope is not clear: i.e. it is not clear what does the “outputting information indicating whether the patron is likely to accept the award;” (emphasis added on “whether”), and how that is done. Further it is not clear how “conveying said information” when “offering said award to said patron” is done. That is, it’s not clear how “information indicating whether the patron is likely to accept the award” is conveyed to the patron.

Claims 17-18 are rejected based on their dependency.

Interpretation of claim 16:

The phrase **“outputting information indicating whether the patron is likely to accept the award; receiving a script containing information relating to conveyance of said award; and offering said award to said patron and conveying said information.”**

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is interpreted, consistent with the specification, as an award for which the patron qualifies yet may not accept based on historical actions, e.g. refusal of the award when previously offered, may nonetheless be presented with a lower priority.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boushy et al. US 6003013 in view of Pierce US 6332126 B.**

8a. **Independent claims 1, 10, 21 and dependent claims 8 and 9:**

BOUSHY discloses:

A computer-implemented method and system for selecting awards to be offered to patrons of an establishment (abstract), the method comprising:

maintaining a patron database storing patron information relating to a plurality of patrons and historical transaction information involving said patrons (abstract; col. 9 lines 52-67)

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monitoring substantially current transaction activity of said plurality of patrons (abstract: updated customer accounts; Figures 3 and 4 and associated text);

regularly assigning a profile (i.e. assigning then updating the profile) to said first patron (col. 5 lines 21-24; col. 10 lines 54-61) based at least upon portions of said historical transaction information pertinent to said first patron and said substantially real time or current transaction activity (abstract; col. 9 lines 52-67; also col. 9 line 67 to col. 10 line 2);

matching 2 or more awards to ones of said profiles (abstract, last line); and

offering said one or more awards to ones of said plurality of patrons assigned to said ones of said profiles (abstract, last line; Figure 4 and associated text).

Boushy discloses several offers based on updated profiles but does not specifically disclose “based upon at least the historical transaction information involving said patrons including the first patron and the current transaction activity of at least the first patron, sorting the two or more awards according to a likelihood of the first patron accepting each award; and outputting, based upon said sorting, at least one recommendation of an award to offer to the first patron.”

However Pierce, in the same computer-based targeted discount and incentives art, discloses consumer transaction histories used to match qualified consumers to targeted merchant discount offers. Offers are automatically prioritized based on their expected value to consumers and consumers receive the highest priority offers for which they qualify. (abstract; col. 2 lines 34-37). The default prioritization can be altered or overridden by the merchants system (abstract). Pierce also discloses, after matching offers to consumers, automatically notifying them of the best offers for which they qualify (col. 4 lines 55-57; Figure

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1.8). In doing so, Pierce discloses the goal is to offer patrons the offers in which they will be most interested (Pierce, col. 2 lines 18-24).

The offers prioritizing in Pierce reads on offers sorting as claimed, (i.e. in order of importance, see definition per [http:// dictionary.reference.com/browse/prioritize](http://dictionary.reference.com/browse/prioritize), printout provided with this Office Action). Since Pierce teaches patrons will be most interested in these offers, Peirce thus discloses "sorting the two or more awards according to a likelihood of the first patron accepting each award" as claimed because logically patrons would be likely to accept what they are "most interested" in.

Thus it would have been obvious to a person having ordinary skill in the art at the time the invention was made (herein a "PHOSITA") to add the above Peirce's teaching of prioritizing offers to Boushy to offer patrons the best offers in which they will be most interested (Pierce, col. 2 lines 18-24).

The combination of BOUSHY in view of PEIRCE does not explicitly disclose recommendations. However Pierce's notifying of the best prioritized offers reads on recommendations. This is because the system or system operators can override the default prioritization (see abstract), thus this prioritized list only acts as a list of suggestions or recommendations of offers to present to the consumer. The motivation to add this limitation of Pierce to Boushy is to allow some degree of flexibility to the system operator in making the offers.

Further it would have been obvious to combine to combine the recommendations of Peirce to Boushy since the claimed invention is merely a combination of old elements (recommendations of offers of Pierce and offers made in Boushy), and in the combination each element merely would have performed the same function as it did separately (i.e. the offers would just have been recommended instead of being imposed), and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 2, 11, 22-23:

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The combination of BOUSHY in view of PEIRCE discloses a method and/or system as in claims 1, 10, or 21 above and BOUSHY further discloses defining a plurality of profiles associated with a corresponding plurality of profile valuations, said assigning further including selecting said profile from said plurality of profiles.

(col. 9 lines 52-67: e.g. VIP customers).

Claims 3, 12, 24:

The combination of BOUSHY in view of PEIRCE discloses a method and/or system as in claims 1, 10, or 21 above and BOUSHY further discloses defining a plurality of awards, said matching further including selecting said award from said plurality of awards based upon a profile valuation of said profile and a value of said award (abstract: distinguished (i.e. more valuable) services for special status (i.e. is higher valuation) customers; col. 12 lines 8-12, 20-22: different levels of points; col. 12 lines 50-55: different levels of comps).

Claims 4, 25:

The combination of BOUSHY in view of PEIRCE discloses a method and/or system as in claims 1, or 24 above and BOUSHY further discloses wherein said profile is characterized by a profile valuation (col. 9 line 2 to col. 10 line 2 : VIP or Premier customers profiles, “worth to the casino” or “theoretical win value” read on profile valuations). Boushy also discloses awards commensurate with customers’ expenditures and her worth to the casino (e.g. based on her “theoretical win value” to the casino) (col. 14 lines 9-25).

However BOUSHY does not specifically disclose said award matched to said profile is being valued at less than or equivalent to said profile valuation.

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However, businesses are not in the business to lose money. Since giving awards values higher than what the business can make of the customer (e.g. based on her “theoretical win value” to the casino) is losing money, it would have been obvious to the PHOSITA to add to the combination of BOUSHY in view of PEIRCE to give an award matched to said profile being valued at less than or equivalent to said profile valuation only, for the above stated goal. Giving more would be inconsistent with Boushy’s goal of giving “commensurate awards” (col. 14 lines 22-24).

Claims 5, 13:

The combination of BOUSHY in view of PEIRCE discloses a method and/or system as in claims 1, or 10 above and further discloses customer’s preferences are collected (col. 9 lines 54).

But neither BOUSHY nor PEIRCE explicitly disclose wherein said matching includes considering award preferences of said patron or plurality of patrons. However since one usually is more receptive to offers that one likes, it would have been obvious to a PHOSITA to add to BOUSHY an offer based on the consumer preferences to increase the odds that the offer would be accepted. These personalized awards would enhance the customer's overall experience with the business and the awards process and might make him or her more likely to return, a goal of Boushy (col. 10 lines 49-53).

Claim 6:

The combination of BOUSHY in view of PEIRCE discloses a method as in Claim 5 above and BOUSHY further discloses wherein said matching further includes considering current conditions (col. 13 lines 29-32). (Note “current conditions” also reads on current activities of the customers, which as stated in discussions of previous claims above, determine level of awards as points and/or comps).

Claims 7 and 14:

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The combination of BOUSHY in view of PEIRCE discloses a method and/or system as in claims 5 or 13 above of matching awards based on customers preferences and further BOUSHY discloses the system monitors customers reactions to offers (redemptions) for analysis to better target subsequent offers (col.14 lines 43-49 and lines 58-60). Since one is more likely to accept an offer that one likes, accepting a particular award is some indication of one's preference for that award. Thus at col.14 lines 43-49 and lines 58-60, BOUSHY discloses matching awards wherein "the award preferences are based at least in part upon reaction of said first patron to other awards previously offered to said first patron".

Claim 15 :

The combination of BOUSHY in view of PEIRCE discloses a method and/or system as in claim 10 above and BOUSHY further discloses generating and receiving a script containing information relating to conveyance of said award (e.g. col. 12 lines 8-12: the number of points, based on an newly determined status, is determined; this information about the points to be offered to customer is the script).

Claims 19-20:

The combination of BOUSHY in view of PEIRCE discloses a method as in claim 1 above and BOUSHY further discloses wherein said historical transaction information is reflective of prior participation of said plurality of patrons in gaming activity managed by said business establishment (abstract) and (claim 20) wherein said profile is selected as a function of participation of said first patron in said gaming activity and in current gaming activity (abstract: updated profile; col. 9 lines 55-67).

8b. Independent claim 16 :**Claim 16 now recites:**

*A method of award offering comprising:
receiving a description of an award, said award being associated with a profile*

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assigned to a patron of an establishment based at least in part upon substantially real-time transaction activity of said patron;
based upon at least historical information involving patron and at least in part upon the substantially real-time transaction activity of said patron, determining a likelihood of the patron accepting the award; and
outputting information indicating whether the patron is likely to accept the award; *receiving a script containing information relating to conveyance of said award; and offering said award to said patron and conveying said information.*

BOUSHY discloses:

A method of award offering comprising:

receiving a description of an award (inherent : system has to define and receive awards levels in order to process the awards as disclosed in the abstract; col. 9 line 2 to col. 10 line 2; e.g. col. 12 lines 8-12 or col. 12 lines 50-56);

said award being associated with a profile assigned to a patron of an establishment based at least in part upon substantially real-time transaction activity of said patron (abstract; col. 9 line 2 to col. 10 line 2; e.g. col. 12 lines 8-12 or col. 12 lines 50-56);

the system determining a likelihood of the patron accepting the award based upon at least historical information involving patron and at least in part upon the substantially real-time transaction activity of said patron (BOUSHY reads on this limitation as it discloses the system monitors customers reactions (i.e. historical information) to offers (col. 14 lines 43-49: “redeeming” means accepting an offer) for analysis to better target subsequent offers (col. 14 lines 43-49 and lines 58-60): i.e. Boushy’s system logically determines that awards previously not redeemed are likely not to be accepted in the future);

generating and receiving a script containing information relating to conveyance of awards (e.g. col. 12 lines 8-12: the number of points, based on an newly determined status, is determined ; this information about the points to be offered to customer is the script);

and offering said award to said patron and conveying information about the awards(Fig. 4 item 454 and associated text) ;

As to “*outputting information indicating whether the patron is likely to accept the award; receiving a script containing information relating to conveyance of said award; and offering said award to said patron **and conveying said information.***” the limitations in bold, are interpreted, consistent with the specification, as an award, for which the patron qualifies yet may not accept based on historical actions (such as reactions to previous offers), may nonetheless be presented with a lower priority.

Boushy not discloses such. However, as discussed above with respect to claims 1, 10 and 21, Pierce, in the same computer-based targeted discount and incentives art, discloses consumer transaction histories used to match qualified consumers to targeted merchant discount offers. Offers are automatically prioritized based on their expected value to consumers and consumers receive the highest priority offers for which they qualify (abstract; col. 2 lines 34-37). The default prioritization can be altered or overridden by the merchants system (abstract). Pierce also discloses, after matching offers to consumers, automatically notifying them of the best offers for which they qualify (col. 4 lines 55-57; Figure 1.8). In doing so, Pierce discloses the goal is to offer patrons the offers in which they will be most interested (Pierce, col. 2 lines 18-24).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the above Peirce’s teaching of prioritizing offers to Boushy to offer patrons the best offers in which they will be most interested (Pierce, col. 2 lines 18-24).

Since Pierce discloses a prioritized lists of offers that it expects patrons will be most interested in (Pierce, col. 2 lines 18-24)., it would further have been obvious to a PHOSITA that

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Pierce would list the awards with a lower likelihood of the patron accepting the award lower in the prioritized list. This is also consistent with Boushy's goal of better targeting subsequent offers (col.14 lines 43-49 and lines 58-60) after learning of patrons reactions to some offers (citations above).

Since Boushy teaches some awards have a lower likelihood of being accepted are known, based on previous patron reactions, it would have been obvious to list these lower on the prioritized list if it is desired to list them. One would be motivated to list them nevertheless-albeit at lower priority, to offer patrons a chance to reconsider them and possibly to accept.

Claim 17:

The combination of BOUSHY in view of PEIRCE discloses a method and/or system as in claim 16 above and further discloses:

recording whether said patron accepts or declines said award (col. 14 lines 43-49: "redeeming" is accepting offer).

Claim 18:

The combination of BOUSHY in view of PEIRCE discloses a method and/or system as in claim 16 above and BOUSHY further discloses receiving descriptions of multiple awards consistent with said profile (col. 12 lines 8-12, 20-22: different levels of points; col. 12 lines 50-55: different levels of comps).

However BOUSHY in view of PEIRCE does not explicitly disclose an indication of a preferred one (interpreted as chosen by the system based on customer preferences) of said multiple awards to be offered to said patron. However, as discussed above with respect to claims 5 and 13, offering personalized offers based on indicated customers preferences, would enhance the customer's overall experience with the business (Boushy, col. 10 lines 49-53). Thus it would

have been obvious to a PHOSITA to add such personalization of the multiple awards to BOUSHY in view of PEIRCE for that advantage.

Response to Arguments

9. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection presented above.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday, Wednesday, and Friday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries

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must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314)..

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

August 13, 2008

/Khanh H. Le/

Examiner, Art Unit 3688

/James W Myhre/

Supervisory Patent Examiner, Art Unit 3688